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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,491	11/03/2000	Gregory E. Ross	RI-69912/MAK	6486

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11/06/2002

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EXAMINER

BARR, MICHAEL E

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 11/06/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/706,491

Applicant(s)

ROSS, GREGORY E.

Examiner

Michael Barr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-22 is/are allowed.
- 6) ☒ Claim(s) 23-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/21/02 has been entered.

Response to Arguments

2. Applicant's arguments and amendments, filed 10/21/02, have been fully considered and reviewed by the examiner. Claims 1-63 are pending.

The applicant has argued that Yoshimura and Hill do not teach the limitations of Claim 23 as they do not teach multiple coatings with the claimed edge alignment. The examiner is not persuaded by the applicant's argument. It appears that the layers of Yoshimura are in substantial registration due to the cutting and punching of the patterns. The applicant's claimed edge forming reads on the cutting and punching of Yoshimura and Hill as the same forms and defines the edges and perimeters of the coating layers. The applicant's claims do not exclude cutting and punching techniques for achieving the claimed registration. Again the applicant's arguments are not commensurate in scope with the claims. Due to the cutting and punching of Yoshimura and Hill, second and subsequent coating layers of Yoshimura and Hill do define the perimeter of the pattern, since it is in registration with the other layers.

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The applicant argues that Yoshimura and Hill do not teach a structure having two bases. However, the claimed second base merely reads on an initial coating layer, which Yoshimura and Hill teach. The applicant has not defined the base to exclude such interpretation. The applicant is arguing limitations outside the scope of the claims.

The applicant argues against the Hill reference, stating that it does not teach the claimed alignment steps or article. The examiner disagrees. Hill teaches transferring a multi-colored design or decal to a transparent substrate, such as glass, using release paper, where the design or decal comprises ceramic ink (Col. 10, lines 2-49), such that the base is provided by applying a silhouette pattern to the paper, where the silhouette pattern can be formed by punching or drilling, and then layers of designs (printed ink) can be applied over the silhouette pattern, such that exact registration between the silhouette pattern and the design layers is achieved (Col. 17, lines 3-27; Col. 18, lines 18-22; Col. 19, lines 1-5). The process teachings of Hill read on the claimed process, as the design layers are in registration with the underlying silhouette pattern. As far as the limitations of Claims 32-35 and 60-63, the punched or drilled silhouette ink pattern and substrate read on the claimed base. The article produced by Hill meets the physical requirements of Claims 36-55.

Due to the extreme breadth of the claims, the Yoshimura and Hill references still read on the claimed invention and are being applied and maintained as previously set forth.

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Claim Objections

3. Claims 35-36 are objected to because of the following informalities: Claim 35 contains the misspelled word “sublimiation” and Claim 36 contains the misspelled word “leeast”.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 60-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 60 cites the limitation of “providing a base substrate having at least three bases”.

It is not clear as to what is meant by this limitation. What is a substrate with at least three bases?

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 23-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoshimura.

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Yoshimura is applied here for the same reasons as given above and in paragraph 3 of the previous office action, No. 8, mailed 4/16/02.

8. Claims 23-63 are rejected under 35 U.S.C. 102(b) as being anticipated by Hill.

Hill is applied here for the same reasons as given above and in paragraph 4 of the previous office action, No. 8, mailed 4/16/02.

Allowable Subject Matter

9. Claims 1-22 are allowed.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Barr whose telephone number is 703-305-7919. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 703-308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 or 703-305-5408 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Michael Barr
Primary Examiner
Art Unit 1762



MB
November 5, 2002